REMARKS/ARGUMENTS

This is in response to the Office Action mailed May 8, 2006 for the above-captioned application. Reconsideration and further examination are respectfully requested.

The Examiner rejected claims 1-13 under 35 USC § 112, second paragraph, as indefinite, asserting that the claim is incomplete. Applicants have amended claim to add the additional method step of "providing a means on the web site for a user to accept a unilateral license for a listed patent." This amendment is support throughout the application, and in particular at S 30-32. This amendment is believed to overcome the rejection and therefore withdrawal of this rejection is urged.

The Examiner has rejected claims 1-13 as anticipated by US 6,728,773 (Corless). Applicant respectfully traverses this rejection. Before addressing the merits of the rejection, Applicant wishes to point out that the limitations of the present claims are quite significant in the context of patent licensing, where they may be of no significant import in the context of licensing software or music or information downloads, which are the primary focus of the Corless invention. In the context of patent licensing, patents themselves are public domain and freely available, for example from the USPTO web site. The license needed for a patent is a license to make copies, but a license to do the thing that is claimed in the patent. Knowledge of who may be interested in a patent license is a form of industrial intelligence that a company may be loathe to give to a patent owner. In contrast, a person who is thinking of buying software is at most likely to be concerned that they won't end up on a mailing list. Thus, it is significant that the method of the present invention allows a prospective licensee to explore patents and license terms without revealing their identity. Further, while software and music and the like (whether sold in a store or as a download) are fairly standard and staple items in commerce, patent licenses are not. Thus, the idea of a patent license web site that acts as a kind of self-service supermarket is a departure from traditional licensing mechanisms, that is remote from the art as discussed in the Corless.

In order to present a *prima facie* argument for anticipation, the burden is on the Examiner to present a showing that each and every element of the claimed invention is found within the reference. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990). Applicants submit that in the present case this burden has not been met.

The Examiner states that Corless teaches the method of claim 1, and cites in particular to col. 2, line 47-col. 3 line 8; col. 5 lines 25-67 and col. 6 lines 8-38. Applicants submit that no disclosure of the process attributed to the reference is in fact provided in this disclosure, or elsewhere in the Corless patent.

As a first matter, Applicant points out that the only mention of patents in the entire Corless document is in the background section at Col. 1, line 48. The disclosure of the Corless invention, however, relates to a type of intellectual property that is distinct from a patent. For example, in the description of the invention, reference is made to "reducing delay in the delivery and use" of intellectual property by a user (Col. 2, lines 44-45), or establishing terms for "accessing said intellectual property (Col. 2, lines 66-67) which are terms suitably applied to the downloading of books or music, but are meaningless in the context of a patent where the document itself is in the public domain, and the license conveyed grants rights separate and apart from access or viewing of the document itself. Indeed, the Corless patent, in the portion cited by the Examiner, refers to treating the "acts of communication and the communicated data ... [as] forms of intellectual property rights and intellectual properties." (Col. 2, lines 54-56).

Furthermore, the Examiner states that the Corless reference discloses unilateral licenses, but has not explained how this teaching is found in the reference. The term "unilateral" does not appear expressly in the reference. Fig. 2 and the discussion thereof show a "digital rights request" 215 or a digital license request 235, but nothing about this discussion states or implies that the grant of rights is unilateral. Furthermore, with respect to Fig. 3, it is noted that the interface between a user/licensee and the property owner is not even shown in this figure. The e commerce site 320 can best be characterized as an agent of the property owner that maintains web site 310. No information concerning the manner in which the user does or does not enter into a license agreement is provided, and certainly there is no teaching of unilateral licensing of patents.

With respect to the dependent claims, the Examiner has similarly not shown where there is a teaching in the reference of the subject matter of the claims. For example, with respect to claim 2, the Examiner states that Corless teaches the absence of a sign in procedure. Corless does no such thing. The cited portion does not mention anything about sign in procedures. The absence of a mention of a sign in procedure is not the same thing as teaching that one is not used. Thus, claim 2 and claims 3-6 which are dependent thereon are not anticipated by Corless.

With respect to claim 3, the Examiner states that Corless teaches providing a copy of the unilateral license for viewing without a potential licensee having to indicate interest in a particular patent but does not explain how the cited passage in the patent provides such a teaching. The cited passage refers to a digital license agreement (DLA) 230, but this is shown in Fig. 2 as being accessed via a DID 205 which is associated with a specific intellectual property 202. Thus, the license can only be accessed based on Fig. 2 after a particular property is selected. This does not teach the limitation of claim 3 and thus claim 3 is not anticipated for this additional reason.

The Examiner asserts that Corless also teaches the limitation of claim 4-6. Since claims 4-6 depend on claims 2 and/or 3 they are not anticipated for the reasons discussed above. Fruthermore, although the examiner says that Corless discloses the sending of an invoice as set forth in Claim 6, such a disclosure is not actually found in the reference.

The Examiner argues that Corless teaches an exclusive unilateral license as set forth in claims 7 and 13 and indicating that a patent unavailable if an exclusive license has been taken. However, the cited portions of the Corless patent do not support this argument. Indeed, the types of intellectual property products to which the Corless patent relate (i.e. those where a product such as software or music and an unlock key are transferred over the internet) would not reasonably be licensed on an exclusive basis. Furthermore, there is no mention of changing an availability indication in response to licensing. Thus, the anticipation rejection of claims 7 and 13 is not supported in the reference.

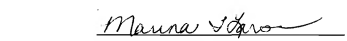
Claim 8 includes the limitation that different patents on the list are associated with different unilateral licenses. Nothing in the cited portions of the Corless patents specifically teach this limitation however.

Claims 9-11 are said to be anticipated by Corless as well. Claim 9 provides for a mechanism where the unilateral license offers different royalty rates depending on the age of the patent (and thus the age of the technology). Claim 10 refers to a unilateral license that has provision for royalty calculation on it. Claim 11 states that the royalty rate is listed on the web site Col. 2, lines 15-26 and col 7, lines 1-11 cited by the Examiner say nothing about royalty rates. Col. 2,. line 46 refers to getting royalty payments faster, but says nothing about determining the amount of such payments. Thus, the basis for the assertion of anticipation is not clear.

Finally, the Examiner teaches the limitation of claim 12 at Col. 5, lines 30 to Col. 6 line 10. Claim 12 requires that more than one form of unilateral license be associated with a listed patent. The cited passage of the reference refers to a number of elements associated with the intellectual property 202, but only one of these is a license agreement. (DLA) Thus, this claim is not anticipated.

For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully submitted,



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